

REMARKS

In the Restriction Requirement, the Examiner indicated that claims 20-39 are subject to restriction under 35 U.S.C. §§121 and 372, because the application allegedly contains inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner restricted the claimed invention to: Group I, including claims 35-39, drawn to a device for controlling the circulation of fluid; and Group II, including claims 20-34, drawn to a process for measuring and controlling the circulation of fluids.

The Examiner states that the inventions of Group I (claims 35-39) and Group II (claims 20-34) do not relate to a single general inventive concept under PCT Rule 13.1 because they allegedly lack the same or corresponding special technical feature. In particular, the Examiner has stated that the technical feature shared in common by the groups as defined by the independent claims appears to be that of: an endoscope positioned in a tank, wherein a channel of the endoscope is coupled to a valve; a hermetic chamber filled with a fluid and having a known volume; and a controller that is capable of controlling and recording the fluid within the chamber from a high level to a low level, wherein the fluid is under pressure. The Examiner asserts that this special technical features is disclosed by U.S. Pub. No. 2002/0182105 (“NAKANISHI”). The Examiner therefore concludes that the special technical feature does not define a contribution over the prior art, such that the inventions listed as Groups I and II do not relate to a single general inventive concept.

Without acquiescing in the Examiner’s assertions of what the special technical feature is and of what NAKANISHI discloses, Applicants respectfully submit that the Examiner’s contention that the inventions of Groups I and II are distinct is not sufficient to support a restriction requirement. In particular, Applicants note that the Examiner’s explanation fails to

identify one of the two criteria for a proper restriction requirement established by the U.S. Patent and Trademark Office policy. As set forth in MPEP §803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required. In the instant case, the Examiner has not even asserted that a serious burden would exist if the if the restriction requirement were not required, much less provided an appropriate explanation of such a serious burden.

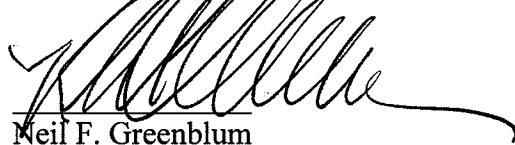
In any event, notwithstanding that the Examiner has failed to even assert the existence of a serious burden, Applicants submit that a serious burden would not exist because the search areas required to examine the invention of Group I would likely overlap into the search areas for examining the invention of Group II, and *vice versa*. That is, Applicants respectfully submit that a complete and adequate search for the device recited in claims 35-39 cannot avoid the subclasses directed to the process recited in claims 20-37, and *vice versa*. Thus, whether the Restriction Requirement is maintained or withdrawn, a complete and adequate search for the recited process will require the Examiner to search the relevant subclasses where the both the device (*i.e.*, Group I) and the process (*i.e.*, Group II) would be classified. Thus, the search for the combination of features recited in the above-identified inventions, if not totally co-extensive, would appear to have a very substantial degree of overlap.

Because the search for the inventions is substantially the same, Applicants submit that no undue or serious burden would be presented in concurrently examining Groups I and II. Thus, for the above-noted reasons, and consistent with the office policy set forth above in MPEP §803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction and species requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper, and Applicants request that the restriction requirement be withdrawn and all pending claims examined on the merits. However, in order to fully comply with the restriction requirement, Applicants have elected, with traverse, the invention defined by Group II, *i.e.*, claims 20-34, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully Submitted,
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